

### **DETAILED ACTION**

Receipt is acknowledged of amendment and remarks filed on 1/14/10.

#### **Status of claims**

**Claims 1-35, 39, 41, 46 and 63-65 are cancelled.** Claims 45 and 47-49 are withdrawn from consideration as being drawn to non-elected species (claim 45 does not have the elected species which is tackifying waxes) and claims 66-68 are withdrawn being drawn non-elected invention.

Claims 36-38, 40, 42-44, and 50-62 are currently examined in the application.

#### ***Claim Rejections - 35 USC § 112***

Claims 36-38, 40, 42-44, and 50-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

The specification discloses tackifying waxes having a tack of greater than or equal to 0.7 N.s and a hardness from 0.05 MPa to 3.5 MPa drawn to formula (I) such as Kester Wax K 82 P ), and Kester Wax 80 P in the instant application at page 9, ll 12-27.

However tacky wax also includes the following waxes. These are:

1. Bayberry wax
2. Hydrogenated jojoba wax
3. Candelillia wax
4. Carnauba wax

5. Hydrogenated rice bran wax
6. Japan wax
7. Jojoba butter
8. Jojoba oil
9. Lanolin wax
10. Microcrystalline wax
11. Mink wax
12. Montan acid wax
13. Montan wax
14. Ouricurry wax
15. Ozokerite wax
16. Rice bran wax
17. Shellac wax
18. Synthetic wax an
19. Synthetic Beeswax ( no formula)

The specification provides insufficient written description to support the genus encompassed by the claim having tackifying waxes which has tack of greater than or equal to 0.7 N.s and a hardness of from 0.05 MPa to 3.5 MPa.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of

ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which waxes are tacky and would possess the property described in claim 1. Adequate written description requires more than a mere statement that it is part of the invention. See *Fiefs v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: ...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.* , 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli* , 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood* , 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the tacky wax having formula 1 shown to possess the required property described in claim 1 and meet the written description provision of 35 USC § 112, first paragraph. The specification does not teach any other waxes that are tacky actually possessing a

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tack of greater than or equal to 0.7 N.s and a hardness of from 0.05 MPa to 3.5 MPa, and thus formula I disclosed in the specification is not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115.)

***Response to Arguments***

Applicant's arguments filed 1/4/10 have been fully considered but they are not persuasive.

Applicants' argue:

*"The present claims do not merely require "tackifying" waxes, but rather require waxes having particular tack and hardness values. The present specification provides detailed protocols for determining tack values and hardness values for a particular wax. See present specification, pages 29 to 31. One of ordinary skill in the art, at the time the present application was filed, would readily be able to determine the tack and hardness values for a wax (and thus whether a wax falls within or outside the scope of the claims) using such protocols. While the present specification includes a limited number of examples of specific waxes (see, e.g., present page 9), one of ordinary skill in the art, using his own knowledge or the additional guidance provided in the present specification could identify tackifying waxes as recited in the present claims (i.e., having specific tack and hardness values). For example, tack and hardness values for many waxes can be readily discerned from literature. If the tack and hardness values*

*for a particular wax cannot be readily discerned from literature, such values can be identified from the protocols in the present specification. As discussed in MPEP §2163, "[t]he written description requirement for a claimed genus may be satisfied ... by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties ..." (emphasis added). Applicants have, in the present case, defined the claimed subject matter using physical properties that are well-understood by those of ordinary skill in the art".*

In response to the above argument, specification describes at page 9, second paragraph tackifying wax and this wax is drawn to formula I. Specification also teaches that this wax is sold by Koster Kunen as Kester wax. The INCI name for this wax is synthetic bees wax.

Additionally applicants' attention is drawn to co-pending application 10/654,887. the specification in co-pending application teaches only Kester wax sold under the trade name Koster K 83 P meeting both the tack value and the hardness value and not any other wax which the meets both the requirements. Amending claim 1 to include the formula describe din the specification would overcome the above rejection.

*The following new grounds of rejection are necessitated by the amendment.*

***Claim Rejections - 35 USC § 103***

Claims 36-38, 40, 42-44, and 50-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patents 6,214, 329 ('329) and 5,783,176 ('176).

Patent '329 teaches mascara compositions and method of curling eyelashes and patent under abstract teaches pigmented emulsion for application to eyelashes. Thus patent explicitly

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teaches claimed mascara in the form of emulsions. Patent '329 at col.5, ll 15-55 teaches waxes and this includes synthetic carnauba wax, synthetic Japan wax, synthetic wax and synthetic Jojoba oil. Patent '429 at col.6, ll 6-15 teaches oils and this is claimed fatty phase. Patent '329 at col.8, ll 46-56 teaches water and the amount of water (claims 53 and 55). Patent '429 at col.11, line 61 through col.12, line 42 teaches film formers and this includes polyurethane (claims 56-58). Patent '429 at paragraph bridging col.s 809 teaches pigments and also fillers and at col.9, ll 18-26 teaches dyes and inorganic pigments (claims 59-61). Patent at col.9, line 45 through col.10 teaches emulsifiers (claim 62).

The difference between the patent and the instant application is patent does not disclose tackifying wax. However, patent '176 teaches tacky wax claimed in instant application as ester. The esters disclosed in the patents are same to that claimed and thus they are waxes and they meet claimed tack value and claimed hardness value. See the abstract, see col.3, ll 30 through col.4, line 65 and see the paragraph bridging col.s 4-5. Patent at col.5, ll 35-45 teaches surfactants and at col.5, ll 52-61 teaches solvents and this includes ethanol and isopropanol (claim 54) and at col.8, ll 39-65 teaches conventional cosmetic additives. See the examples. The preferred ester is C<sub>19-39</sub> alkyl hydroxy stearates.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare mascara compositions in the form of emulsions using fatty phase, pigments, film formers, colorants, water and other additives taught by patent '329 and substitute the synthetic wax or synthetic carnauba wax, synthetic Japan wax or synthetic Jojoba oil of patent '329 to ester of patent '176 (claimed in instant application as tacky wax and also known as synthetic bees wax since INCI name for Kester wax is synthetic bees wax). One of

ordinary skill in the art would substitute the functional equivalents expecting that the ester of patent '176 (INCI name is synthetic bees wax) can also be used in mascara compositions in the form of emulsions. This is a prima facie case of obviousness.

In view of the amendment, applicants' arguments with respect to ODP are moot. See ODP based upon co-pending application in view of patent '429.

### ***Double Patenting***

Claims 36-38, 40, 42-44 and 50-62 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 and 73-91 and 96 of copending Application No. 10/654,887 in view of U.S. Patents 6,214, 329 ('329).

Both the instant application and co-pending application use tacky wax, film forming polymer and other additives. There is overlap of subject matter in the instant and co-pending application. Although 10/654, 887 include an additional requirement, i.e., additional waxes, emulsifiers, the use of the claim language "comprising" in instant application permits these additional requirements. Instant application is claiming mascara compositions in the form of emulsion and in co-pending application the compositions are not in the form of emulsions. However it would be obvious to one skilled in the art to use compositions in the form of emulsions and use the compositions as mascara taught by patent '329 which teaches mascara compositions having wax and also in the form of emulsions.

This is a provisional obviousness-type double patenting rejection.

Claims 36-38, 40, 42-44 and 50-62 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over 1-20 and 79-96 and 102-107 of copending Application No. 10/654,907 in view of U.S. Patents 6,214, 329 ('329).

Both the instant application and co-pending application use tacky wax, film forming polymer and other additives. There is overlap of subject matter in the instant and co-pending application. Although 10/654, 907 include an additional requirement, i.e., additional waxes, emulsifiers, the use of the claim language "comprising" in instant application permits these additional requirements. Instant application is claiming mascara compositions in the form of emulsion and in co-pending application the compositions are not in the form of emulsions. However it would be obvious to one skilled in the art to use compositions in the form of emulsions and use the compositions as mascara taught by patent '329 which teaches mascara compositions having wax and also in the form of emulsions.

This is a provisional obviousness-type double patenting rejection.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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